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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,782	02/27/2004	Chang Chin-Kang	DF-04300	9434

7590 05/17/2005

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EXAMINER
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JOHNSON, JERROLD D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/789,782

Applicant(s)

CHIN-KANG, CHANG

Examiner

Jerrold Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to combination of a handle and a wafer box, classified in class 206, subclass 710.
- II. Claims 14-16, drawn to the subcombination of a handle, classified in class 16, subclass 422.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed does not require the particulars of the subcombination as claimed for patentability, namely that holding element is mounted on the connecting component, as is set forth in the subcombination claim 14. Accordingly, claim 1, evidences that the combination as claimed does not require the particulars of the subcombination. The subcombination has separate utility, for example the handle may be used on a trunk.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Jonathon Owens on 04/06/05 a provisional election was made without traverse to prosecute the invention of Group II, claims 14-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-1<sup>3</sup>~~4~~ are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "36" and "37" have both been used to designate the positioning portion, as well as the urging portion. For example, in Fig. 3 the positioning portions are designated 36, but after the handle is rotated to the position shown in Fig. 5, one of the previously designated elements 36 is designated 37. The examiner suggests that elements 36 and 37 be renumbered 36a-d, to avoid this confusion. Additionally, element 45 designated in the spec as the gap-connecting portion is not shown in the drawings. Does the gap-connecting portion 45 comprise the pillar 70, as is believed to be set forth in withdrawn claim 12 (note that the last line of claim 12 is confusing)? Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

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replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 14 is objected to because of the following informalities: Claim 14 is drawn to the subcombination of the handle. Accordingly, in line two, an intended use limitation such as "a connecting component for connection to an object" would add clarity, as currently the claim could be construed possibly as setting forth a combination. Additionally, a "for" should be included before "being" inline 7, as the claim could currently be interpreted as setting forth the combination of a handle and a human hand, which would necessitate a 35 USC 101 rejection. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Nyseth et al. US 6,010,008.

Re claim 14, Nyseth discloses a handle device in Fig. 18, comprising: a connecting component 28 connected to an object, comprising: an engaging portion 284 for being engaged with said object; a positioning portion 276 for positioning said connecting component on said object; and a holding element 240 mounted on said connecting component and having a holding portion (for) being evenly and securely held by an operator with four digits thereof so as to transport said object.

Re claim 15, the object is a wafer box main body.

Re claim 16, said connecting component further comprises an urging portion for urging said object (the inner surface of the positioning portions 276 which contact the wafer box).

Note that the engaging portion, positioning portion, and urging portion are essentially written in 112 6<sup>th</sup> paragraph format as setting forth the element by the function they perform. However, unless the applicant sets forth these limitations under the guidelines of MPEP 2181 by re-writing them as “means for engaging, means for positioning, means for urging”, or states unequivocally in the record that the limitations are to be construed under 35 USC 112 6<sup>th</sup> paragraph, each of these limitations must be given their broadest interpretation.

***Allowable Subject Matter***

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Claim 14, like claim 1, would be allowable if it is first re-written to include the "urging portion" as well as to and the engaging portion and positioning portion, as are already set forth. Additionally, each of these elements need to be either re-written to conform to proper 112 6<sup>th</sup> paragraph format as set forth in 2181 (means for engaging...), or there needs to be a statement in the record that these limitations are to be construed under 35 USC 112 6<sup>th</sup> paragraph. However, there are minor informalities in claims 1-13 which must be addressed, such as the necessity to define what is "vertical" with respect to the wafer box, so that "vertical" or "horizontal" of the handle are clearly understood, and claim 9 includes limitations for which there is no antecedent basis in the specification. The problem with claim 12 has already been set forth in the objection to the drawings. All claims should be reviewed to meet the requirements of 35 USC 112 2<sup>nd</sup> paragraph.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerrold Johnson whose telephone number is 571-272-7141. The examiner can normally be reached on 9:30 to 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDJ

A handwritten signature in black ink, appearing to read "Mickey Yu", with a stylized, flowing script.

Mickey Yu  
Supervisory Patent Examiner  
Group 3700